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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,673	09/29/2003	Aaron Bangor	1033-T00533	2302
60533 7590 03/18/2008 TOLER LAW GROUP 8500 BLUFFSTONE COVE SUITE A201 AUSTIN, TX 78759				
EXAMINER PHANTANA ANGKOOK, DAVID				
ART UNIT		PAPER NUMBER		
2179				
MAIL DATE		DELIVERY MODE		
03/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/673,673

Applicant(s)

BANGOR ET AL.

Examiner

David Phantana-angkool

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 13, 14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13, 14, 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the following communications: RCE filed on January 8th, 2008
2. Claims 1-9, 11, 13, 14 and 16-20 are pending claims.
3. Applicants amended claims 1, 11, 16, and 20.
4. Applicants canceled claims 10, 12, and 15.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/08/2008 has been entered.

Claim Rejections - 35 USC § 101

6. **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1, 2, and 6 - 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1, 2, 6, 8, and 9 do not positively recite statutory subject matter.

In this case, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material *per se* (see *Warmerdam*, 33 F.3d at 1360 USPQ2d at 1759), falling under the "process" category (i.e. inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process means, art, or method, and includes a new or a known process, machine, manufacture, composition of matter or material").

Functional descriptive material: "data structures" representing descriptive material *per se* or computer program representing computer listing *per se* (i.e. software *per se*) when embodied in a computer-

readable media are still not statutory because they are not capable of causing functional change in the computer. However, a claimed computer- readable storage medium encoded with a data structure, computer listing or computer program, having defined structural and functional interrelationships between the data structure, computer listing or computer program and the computer software and hardware component, which permit the data structure's, listing or program's functionality to be realized, is statutory (see MPEP §2106).

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C.101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. **Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman et al., US PG PUB# 2004/0119761 A1 (hereinafter Grossman) in view of Padwick, "Special Edition Using Microsoft Outlook 2000" (hereinafter Padwick).**

As for independent claim 1:

Grossman shows messaging system comprising:

- *an address menu having an identification field with a plurality of associated address fields, each of the plurality of address fields operable to maintain an address for a messaging receipt option; a graphical user interface operable to present the address menu (0053, Fig. 7 shows multiple address fields for a messaging receipt option);*
- *an address box associated with an outgoing electronic message capable of receiving multiple user-selected addresses from the plurality of address fields of identification field for subsequent transfer of the outgoing electronic message to the user-selected addresses (Grossman shows an address box receiving multiple addresses through use of single selector in (Fig. 4# 410, Fig. 5#510, 520, and 530; Para. 0062-0063).*

Grossman does not specifically show a selector to initiate presentation of the address menu on the graphical user interface for user selection of multiple addresses from the plurality of address fields of identification field. In the same field of invention Padwick teaches a selector (Figure 3.32 "To" to initiate presentation of the address menu on the graphical user interface for selecting multiple addresses as shown in "Creating a Message", Pgs. 6, 7, and Figure 3.32 in Padwick and also shown below:

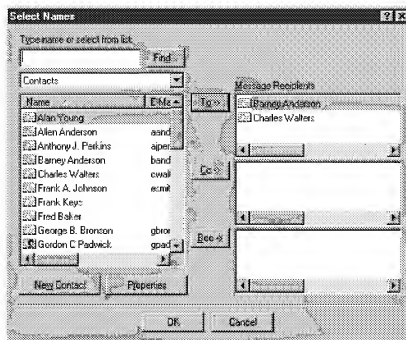


Figure 3.32. The Select Names dialog box shows the names in your Address Book. These names are listed at the left side of the dialog box.

Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Grossman messaging system to incorporate a selector to initiate presentation of the address menu on the graphical user interface for user selection of multiple addresses from the plurality of address fields of identification field as taught by Padwick, thus allowing the user to select a plurality of names and addresses from the Message form (Padwick, "Creating a Message", Pg. 6).

As for dependent claim 2:

Grossman-Padwick suggests the *system of claim 1 wherein the identification field maintains a contact alias for a potential recipient of an outgoing message* (0079). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Grossman for the same reason as stated previously above (see claim 1 *supra*).

As for dependent claim 3:

Grossman-Padwick suggests the *system of claim 1, further comprising: a computer storing a first address menu for a first user and a second address menu for a second user; and an interface engine associated*

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with the computer and operable to communicatively couple a remote computer associated with the first user to the computer storing the first address menu (0014, 0046, 0075). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Grossman for the same reason as stated previously above (see claim 1 *supra*).

As for dependent claim 4:

Grossman-Padwick suggests the *system of claim 3 wherein the computer storing the first address menu is operable to initiate communication of internet protocol packets (Fig. 4# 450).* It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Grossman for the same reason as stated previously above (see claim 1 *supra*).

As for dependent claim 5:

Grossman-Padwick suggests the *system of claim 3, wherein the remote computer is communicatively coupled to the computer storing the first address menu via a cable modem (0075).* It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Grossman for the same reason as stated previously above (see claim 1 *supra*).

As for dependent claim 6:

Grossman-Padwick suggests the *system of claim 1, further comprising: a first address field associated with the identification field, the first address field for maintaining a first address type of a contact; and a second address field associated with the identification field, the second address field for maintaining a second address type of the contact (Fig. 4 shows different types of contact information associated with a user).* It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Grossman for the same reason as stated previously above (see claim 1 *supra*).

11. Claims 11, 13, 14, 16-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman et al., US PG PUB# 2004/0119761 A1 (hereinafter Grossman) in view of Shavit et al, US PG PUB# 2002/0160757 (hereinafter Shavit).

As for independent claim 11:

Grossman shows a messaging method comprising:

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- *initiating presentation of a first user-selectable item for viewing a collection of contact information* (Grossman, 0048);
- *receiving a signal indicating a user selection of the first user-selectable item* (Grossman, 0050);
- *initiating a graphical user interface (GUI) element to present an address menu comprising contact information for at least one potential addressee* (Clicking on Fig.4# 470, Para. 0062 will initiate a graphical user interface displaying an address menu to display a plurality of addresses),

Grossman does not specifically show (1) the contact information including a first selectable address and a second selectable address for the at least one potential addressee (2) recognizing a selection of the first address and the second address; (3) initiating presentation of the first address and the second address in an address box associated with an outgoing electronic message. In the same field of invention Shavit teaches a contacts database which stores a list of addresses of a potential addressee (Shavit, 0034). Shavit allows the user to configure a priority table to send a message to a desired recipient with a plurality of addresses (Shavit, 0007). Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Grossman messaging system to incorporate (1) the contact information including a first selectable address and a second selectable address for the at least one potential addressee (2) recognizing a selection of the first address and the second address; (3) initiating presentation of the first address and the second address in an address box associated with an outgoing electronic message as taught by Shavit, thus allowing the user to send a message to a desired recipient with a plurality of addresses (Shavit, 0007).

As for dependent claim 13:

Grossman- Shavit suggests the *method of claim 11, further comprising: receiving a signal indicating a request to prepare an outgoing message; and initiating presentation of a messaging graphical user interface (GUI) to present a message composition template comprising an address box and a message input box* (Grossman, Figs 4 and 7, 0059). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the graphical user interface of Grossman for the same reason as stated previously above (see claim 11, *supra*).

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As for dependent claim 14:

Grossman- Shavit suggests the *method of claim 11, further comprising: modifying the address menu in response to a user input comprising addition of another potential addressee; subsequently initiating the graphical user interface (GUI) element; and presenting the address menu as comprising contact information for the at least one potential addressee and the another potential addressee* (Grossman, 0059). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the graphical user interface of Grossman for the same reason as stated previously above (see claim 11, *supra*).

As for dependent claim 16:

Grossman- Shavit suggests the *method of claim 11, further comprising: initiating presentation of a second user-selectable item associated with sending the outgoing electronic message to the first address and the second address in the address box* (Grossman, 0059 and 0060). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the graphical user interface of Grossman for the same reason as stated previously above (see claim 11, *supra*).

As for dependent claim 17:

Grossman- Shavit suggests the *method of claim 16, further comprising: receiving a signal indicating a user selection of the second user-selectable item; and initiating communication of the outgoing message to the first address and the second address* (Grossman, 0053, 0059 and 0060). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the graphical user interface of Grossman for the same reason as stated previously above (see claim 11, *supra*).

As for dependent claim 18:

Grossman- Shavit suggests the *method of claim 17 further comprising attaching a file to the outgoing message* (Grossman, Fig. 4). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the graphical user interface of Grossman for the same reason as stated previously above (see claim 11, *supra*).

As for dependent claim 20:

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Claim 20 contains similar substantial subject matter as claimed in claim 11 and is respectfully rejected along the same rationale.

12. **Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman et al., US PG PUB# 2004/0119761 A1 (hereinafter Grossman) in view of Padwick, "Special Edition Using Microsoft Outlook 2000" (hereinafter Padwick), and in further view of Landesmann, US# 7,072,943 B2.**

As for dependent claims 7 and 8:

Grossman teaches the above limitations (see claim 1, *supra*). Grossman shows/suggests a messaging system that has the ability to send messages to a plurality of communication type such as email address, instant messaging, facsimile, and telephone. Grossman further shows the messaging system have the ability to place a call to a desired contact. Grossman and Padwick does not specifically shows a *short messaging service address*, an *enhanced messaging service address*, and a *multimedia messaging service address* as communication type. However in the same field of invention Landesmann teaches a system which route email to a handheld device such as PDA or Cell phone (Landesmann, 6: 13-40). In addition an Official Notice is taken that communication type: *short messaging service address*, an *enhanced messaging service address*, and a *multimedia messaging service address* are well known in the art, such as shown by the following: (1) O'Neil et al, US# 7,127,232 R2 and (2) Shavit et al., US PG PUB#2002/0160757. Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention was made modify the system of Grossman and Padwick to incorporate routing email messages to a mobile device as taught by Landesmann, thus allowing the desired contact to receive messages through their handheld device (Landesmann, 6: 13-40)

13. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman et al., US PG PUB# 2004/0119761 A1 (hereinafter Grossman) in view of Padwick, "Special Edition Using Microsoft Outlook 2000" (hereinafter Padwick) in view of Landesmann, US# 7,072,943 B2, and in further view of Fernandes, US# 6,014,135.**

As for dependent claim 9:

Grossman shows/suggests the above limitations (see claims 1, 7 and 8, *supra*). Grossman further shows/suggests the messaging system sharing file between the user and the desired contact (Fig. 4). Grossman, Padwick, and Landesmann do not specifically show the *system of claim 8, further comprising an attachment engine operable to convert a file attached to an outgoing message into a format receivable by a device associated with a messaging receipt option*. Fernandes teaches a messaging system which converts one message format type to another message type (Fernandes, 13: 45-53). Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Grossman, Padwick, and Landesmann to incorporate the converting message type function in a messaging system as taught by Fernandes, thus allowing the desired user to receive the intended message through various devices.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grossman et al., US PG PUB# 2004/0119761 A1 (hereinafter Grossman) in view of Shavit et al, US PG PUB# 2002/0160757 (hereinafter Shavit) in view of Fernandes, US# 6,014,135.

As for dependent claim 19:

Grossman shows the above limitations (see claims 11, *supra*). Grossman further shows the messaging system sharing file between the user and the desired contact (Fig. 4). Grossman and Shavit do not specifically show the *method of claim 18 further comprising converting the file into a format receivable by a device associated with the first address*. Fernandes teaches a messaging system which converts one message format type to another message type (Fernandes, 13: 45-53). Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Grossman and Shavit to incorporate the converting message type function in a messaging system as taught by Fernandes, thus allowing the desired user to receive the intended message through various devices.

It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any

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way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re *Heck*, 699 F.2d 1331, 1332-33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re *Lemelson*, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)).

The Examiner notes MPEP § 2144.01, that quotes *In re Preda*, 401 F.2d 825,159 USPQ 342, 344 (CCPA 1968) as stating “in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” Further MPEP 2123, states that “a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

Response to Arguments

15. Applicant's arguments with respect to claims 1-9, 11, 13, 14, and 16-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Phantana-angkool whose telephone number is 571-272-2673. The examiner can normally be reached on M-F, 9:00-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilin Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DP

/David Phantana-angkool/
Examiner, Art Unit 2179

/Weilun Lo/

Supervisory Patent Examiner, Art Unit 2179